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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/517,853

12/14/2004

Satoshi Yonehara

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9018

52835

7590

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EXAMINER

MARTIN, PAUL C

ART UNIT

PAPER NUMBER

1657

MAIL DATE

DELIVERY MODE

05/24/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/517,853

Applicant(s)

YONEHARA ET AL.

Examiner

Paul C. Martin

Art Unit

1657

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 May 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1,3 and 6-21.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
see continuation sheet.
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). 4/11/07,3/21/07,1/22/
13. ☐ Other: _____.

Claims 1, 3 and 6-21 are pending in this application and were examined on their merits.

The rejection of Claims 1, 3 and 6-21 under 35 U.S.C. § 112, 2nd paragraph as being indefinite for failing to point out and distinctly claim the subject matter which applicant regards as the invention has been withdrawn due to the Applicant's amendments to the Claims filed 05/07/07.

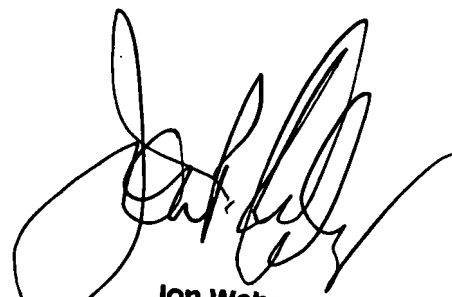
Claims 1, 3 and 6-21 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Komori et al. (2002/0025546 A1) in view of Oshiro et al. (1982) for reasons of record set forth in the previous Office actions.

The Applicant's arguments filed 05/07/07 have been fully considered but they are not found to be persuasive.

The Applicant argues that there is no motivation to combine the Komori et al. and Oshiro et al. reference because Claims 1, 20 and 21 are directed to a method of measuring glycated protein in a sample containing hemoglobin and includes specific sulfur-containing compounds or a combination of sulfur and nitrogen-containing compounds, and Komori et al. does not disclose the sulfur or nitrogen containing compounds; that Komori et al. fails to disclose or suggest eliminating the influence of hemoglobin, and that Oshiro et al. is not directed to measuring a glycated protein and merely teaches hemoglobin determination using sodium lauryl sulfate; that Komori et al. fails to disclose or suggest eliminating the influence of hemoglobin; and that the teaching of sodium lauryl sulfate by Oshiro et al. does not render obvious the use of lithium lauryl sulfate (Remarks, Pg. 7, Lines 27-30 and Pg. 8, Lines 1-27).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The Komori et al. reference is drawn to the measurement of glycated proteins in samples containing hemoglobin, while the Oshiro et al. a method of hemoglobin determination in the presence of the sulfur compound sodium lauryl sulfate. Instant Claims 1, 20 and 21 only require the presence of one sulfur-containing compound, and it is though combination of both references and the principle of the of the obviousness of functionally equivalents that the limitations of the instant invention are met.

The sodium lauryl sulfate of Oshiro et al. would have performed the elimination of hemoglobin interference whether or not the ability to do so was recognized by the prior art, and it is maintained that those of skill in the art would have recognized that sodium lauryl sulfate is a functional equivalent of lithium lauryl sulfate. In response to applicant's argument that the use of sulfur compounds eliminate the influence of hemoglobin, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).



Jon Weber
Supervisory Patent Examiner